

**C. REMARKS**

Claims 1-12 remain pending herein.

**Claim Rejections – 35 U.S.C. § 102**

Claims 1-12 stand rejected under 35 U.S.C. 102(b) as being anticipated by Beck (US Patent No. 5,903,723, herein referred to as “Beck”). “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference”. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed Cir. 1987). Furthermore the reference must be an enabling disclosure of each and every element as set forth in the claim. *In re Hoecksmas*, 158 USPQ 596, 600 (CCPA 1968); *In re LeGrive*, 133 USPQ 365, 372 (CCPA 1962). Because the Examiner does not show that Beck teaches or inherently describes each an every element of claims 1-12 or enables each and every element of these claims, these claims are not anticipated, the rejection should be withdrawn, and the claims should be allowed.

As will shown below, Beck does not teach or inherently describes in a distributed computer system including a server and a client, the server including a message store, a method for delivering Web content within a body section of electronic mail messages as claimed in the present application. Claims 1-12 are therefore patentable and should be allowed. Applicants respectfully traverse each rejection individually, and requests reconsideration of claims 1-12.

**Claims 1, 5, and 9**

Responsive to Examiner’s rejection of claim 1, Applicants respectfully submit that Beck does not anticipate the invention of claim 1 or enable the elements of claims 1.

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The Examiner argues that the claim element "downloading Web content associated with the hyperlink into the message store at the server" is taught by Beck at column 5, lines 6-33. Applicants respectfully submit that Beck does not teach Applicants' claimed invention and in fact, teaches away from the presently claimed invention. Beck teaches "the e-mail message 401 is transmitted along with a relatively small **attachment reference** 402" (Col. 5, lines 11-13, emphasis added) when transmitting the message to the user or client (see Col. 5, line 11 referencing PC 212). Furthermore, Beck teaches that "instead of transmitting the attachment by value, the attachment is transmitted 'by reference'" (Col. 5, lines 15, 16.) Thus, Beck teaches to include an attachment reference into the message instead of transmitting the attachment to the user. Beck does not download web content to the message store on the server, and instead teaches a method to avoid doing so.

Also, Beck teaches that an "attachment reference 402 is either a logical pointer or logical path that indicates either where the attachment, or a copy of it, resides" (Col. 6, lines 29-31). In addition, Beck teaches that "the attachment **reference** is transmitted from the sender to the at least one recipient" (Col. 2, lines 3 and 4, emphasis added.) Thus, Beck does not transmit the corresponding content of the attachment but a pointer or reference to the attachment. Therefore, there is no teaching or suggestion in Beck for Applicants' claimed element "transmitting the mail message and the **corresponding Web content** for display at the client".

Beck seeks to avoid sending both the message and attachment content, thereby teaching away from the presently claimed invention (see Col. 8, line 63-Col. 9, line 16.)

Thus, Applicants submit that claim 1 is not anticipated under 35 U.S.C. 102(b) by Beck because each and every element of claim 1 is not found, either expressly or inherently described in Beck. Therefore, Applicants respectfully request allowance of claim 1. Claims 5 and 9 contain limitations similar to those in claim 1, and are respectfully submitted to be patentable over Beck for the reasons set forth above. Withdrawal of the rejections to these claims is respectfully requested.

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**Claims 2, 6, and 10**

Responsive to Examiners rejection of dependent claims 2, 6, and 10, Applicants respectfully submit that because Beck does not anticipate claim 1, upon which dependent claims 2, 6, and 10 claims rely, then Beck does not anticipate these dependent claims and the rejections of dependent claims 2, 6, and 10 should be withdrawn.

**Claims 3, 7, and 11**

Regarding Examiner's rejection of claim 3, Applicants amend claim 3, and submit that Beck does not teach the claim elements "determining whether the Web content exceeds a predetermined size; and in response to determining that the Web content exceeds a predetermined size, compressing the Web content that exceeds the predetermined size, at the server" as claimed by Applicants. Beck teaches that "attachment 420 may be compressed (to minimize storage space and network bandwidth consumed)" (Col. 6, lines 38-40). In the teaching by Beck, "e-mail system 600 may employ encryption and/or compression techniques such as discussed above with regard to e-mail message format 400 of FIG. 4 so that fewer network resources are required to transmit (compressed) attachment 611 if and when it is retrieved by the recipient" (Col. 14, lines 17-21). Beck is silent in determining any limitations for compressing e-mail messages. Beck does not teach making the determination to compress as claimed by applicants, and in particular, does not teach "determining whether the Web content exceeds a predetermined size; and in response to determining that the Web content exceeds a predetermined size, compressing the Web content that exceeds the predetermined size, at the server" as claimed by Applicants.

Thus, Applicants submit that claim 3 is not anticipated by Beck because each and every element of claim 3 is not found, either expressly or inherently described in Beck. Thus, Applicants respectfully request allowance of claim 3. Claims 7 and 11 contain limitations similar to those in claim 3,

and are respectfully submitted to be patentable over Beck for the reasons set forth above. Withdrawal of the rejections to these claims is respectfully requested.

Furthermore, Applicants respectfully submit that because Beck does not anticipate claim 1, and the corresponding claims 5 and 9, upon which dependent claims 3, 7, and 11 rely, then Beck does not anticipate these dependent claims and dependent 3, 7, and 11 should be allowed.

#### **Claims 4, 8, and 12**

Responsive to Examiner's rejection of claim 4, Applicants submit that Beck does not teach "determining whether the client has a preset time for downloading messages containing Web content; and in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached" as claimed by Applicants. The Examiner states that Beck teaches both elements of claim 4 at column 13, lines 31-39. Applicants respectfully traverse Examiner's rejection. Beck teaches at column 13, lines 31-39:

"If accepted, the URL 627 and a corresponding hypertext link (which allows the recipient to read the attachment pointed to with pointer 630 by the URL) are incorporated onto the recipient's mail page, stored at server 620. Therefore, at a later time, the recipient 622 can view the incoming mail page and retrieve messages, including message 626 and attachment 611, if desired, as attachment 611 is stored locally to sender 612 at server 610 but visible to users of Internet 601 such as recipient 622." (Col. 13, lines 31-39).

The reference above does not teach "determining whether the client has a preset time for downloading messages containing Web content; and in response to determining that a preset time for downloading Web content exists, caching the message and Web content at the server until the preset time is reached" as claimed by Applicants. Furthermore, the claimed invention is not found anywhere in Beck.

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Thus, Applicants submit that claim 4 is not anticipated by Beck because each and every element of claim 4 is not found, either expressly or inherently described in Beck. Thus, Applicants respectfully request withdrawal of rejection of claim 4. Claims 8 and 12 contain limitations similar to those in claim 4, and are respectfully submitted to be patentable over Beck for the reasons set forth above. Withdrawal of the rejections to these claims is respectfully requested.

Furthermore, Applicants respectfully submit that because Beck does not anticipate claim 1, and corresponding claims 5 and 9, upon which dependent claims 4, 8, and 12 rely, then Beck does not anticipate these dependent claims and dependent 4, 8, and 12 should be allowed.

#### Conclusion

Claims 1-12 stand rejected under 35 U.S.C. 102(b) as being anticipated by Beck, et al. (US Patent No. 5,903,723). For the reasons set forth above, it is respectfully submitted that the cited reference does not teach each and every element of the claimed invention as required by 35 U.S.C 102(b). The rejection of claims 1-12 should therefore be withdrawn, and the claims should be allowed. The additional references cited by the Examiner have been reviewed and the presently claimed invention is believed to be patentable thereover. Reconsideration of claims 1-12 and generation of a Notice of Allowance are requested. The Examiner is invited to telephone the undersigned if he feels that such discussion could speed allowance of this case.

Respectfully submitted,



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